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Date: APRIL 12, 2005

To: EXAMINER BONSHOCK, DENNIS G.
U.S. PATENT AND TRADEMARK OFFICE
Fax #: (703) 872-9306From: FRANK C. NICHOLAS
Phone #: (847) 424-2521

Client/Matter No.: AUS920010923US1 (9000/81)

of Pages: 8
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Attorney Docket No.	AUS820010923US1 (9000/81)
Application Number	08/981,877
Filing Date	OCTOBER 18, 2001
First Named Inventor	ANTHONY E. MARTINEZ
Group Art Unit	2173
Examiner	BONSHOCK, DENNIS G

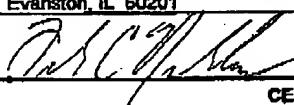
ENCLOSURES (check all that apply)

<input type="checkbox"/> Amendment	<input type="checkbox"/> Assignment Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> After Final	<input type="checkbox"/> Drawings:	<input checked="" type="checkbox"/> Reply Brief
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> After Allowance Communication to Group	<input type="checkbox"/> Proprietary Information
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<input type="checkbox"/> Supplemental Information Disclosure Statement, PTO-1449, an	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/>
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CALCULATION OF FEE

	Claims After Amendment	Minus	Highest No Previously Paid For	Present Extra	Small Entity		Large Entity	
					Rate	Add'l Fee	Rate	Add'l Fee
Total		Minus		0	x \$25=	0	x \$60=	
Indep.		Minus		0	x \$100=	0	x \$200=	
First Presentation of Multiple Dep. Claim					+ \$180=	—	+ \$360=	
					total add'l fee	\$ 0	total add'l fee	\$ 0

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	FRANK C. NICHOLAS Registration No. 33,983 CARDINAL LAW GROUP 1603 Orrington Avenue, Suite 2000 Evanston, IL 60201
Signature	

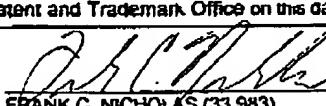
Date April 12, 2005

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Attorney Docket No	AUS920010823U61 (9000/81)
Application Number	09/981,877
Filing Date	OCTOBER 18, 2001
First Named Inventor	ANTHONY E MARTINEZ
Group Art Unit	2173
Examiner	BONSHOCK, DENNIS G

ENCLOSURES (check all that apply)

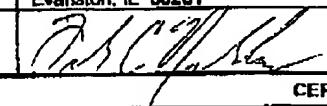
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<input type="checkbox"/> Express Abandonment Under 37 CFR 1.138	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/>
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CALCULATION OF FEE

	Claims After Amendment		Highest No Previously Paid For	Present Extra
Total		Minus		0
Indep.		Minus		0
First Presentation of Multiple Dep. Claim				

Small Entity		or	Large Entity		
Rate	Add'l Fee		Rate	Add'l Fee	
x \$25=	0		x \$50=		
x \$100=	0		x \$200=		
+\$180=	—		+\$360=		
total add'l fee		\$ 0	total add'l fee		\$ 0

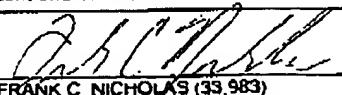
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or individual name	FRANK C. NICHOLAS Registration No 33,983 CARDINAL LAW GROUP 1603 Orrington Avenue, Suite 2000 Evanston, IL 60201
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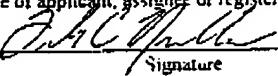
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FRANK C. NICHOLAS (33-983)
Name of applicant, assignee or registered representative



Signature

April 12, 2005
Date of Signature

PATENT
Case No. AUS920010923US1
(9000/81)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:)
ANTHONY E. MARTINEZ, ET AL.) Examiner: BONSHOCK, DENNIS C.
Serial No.: 09/981,877)
Filed: OCTOBER 18, 2001) Group Art Unit: 2173
Title: METHOD OF PREVIEWING A)
GRAPHICAL IMAGE CORRESPONDING)
TO AN ICON IN A CLIPBOARD)

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22202-1450

Dear Sir:

Appellants respectfully present their Reply Brief as follows:

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The Examiner fails to introduce any new support for his §102(a) rejection in his answer brief. Appellants maintain that the "MSWord" reference is not a §102(a) reference, and that "MSWord" does not disclose each element of the claims.

Claim 1 requires, *inter alia*, "displaying the graphical image associated with the icon in response to the icon preview instruction." Thus, a graphical image associated with the icon is displayed in response to an icon preview instruction. Three elements are present in this section of the claim: 1) an icon preview instruction, 2) an icon, and 3) a graphical image associated with the icon. In order to anticipate the claim, "MSWord" must disclose each element.

An "icon" is a picture on a screen that represents a specific file, directory, window, option, or program, according to an exemplary definition from *The American Heritage® Dictionary of the English Language, Fourth Edition*. In contrast, "text" is, according to the same source, "the original words of something written or printed, as opposed to a paraphrase, translation, revision, or condensation."

At most, the "reference" discloses that a *text* sample of the clipboard icon is disclosed upon a mouse action, and not the display of a *graphical* image associated with the icon. See, MS Figure 2. The Examiner's attempt to argue that *text* and *graphics* are identical is flawed.

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A box surrounding the graphical image of text is not associative of an icon, in contrast to the Examiner's arguments. See, p.6 of the Examiner's answer. A box is not associative of a "W."

Regardless of the merits of Appellants argument above, however, there can be no proper rejection of the claims based on "MSWord." While the Examiner correctly identifies the strictures of §102(a), the Examiner's statement that a copyright date "alone proves that the MSWord reference was known and used prior to the filing of the applicants claimed invention" illustrates a fundamental misconception of patent law.

The law is clear that a document only qualifies as a reference under 35 U.S.C. §102(a) "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that person interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." See MPEP 2128, *In re Wyer*, 655 F.2d 221 (CCPA 1981).

In contrast, 17 U.S.C. §102 states that "copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." Thus, the fact that a document claims copyright *does not mean* that the document has been disseminated or otherwise made available. Furthermore, that a document claims copyright to a date more than one year prior to the instant filing date does not mean that a particular portion of the document was included in the copyrighted work at the time that the copyright notice was affixed. For example, the Examiner indicates that the copyright notice claims copyright

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“1983-1999” but does not allege that the document was the same document during that time period, and does not allege that after 1999, the document (“MSWord”) is the same document that was subject to a copyright claim in 1999.

The “MSWord” reference was generated by the Examiner more than 2.5 years after the instant filing, and this reference cannot support this rejection.

Allowance of claim 1, and all claims depending therefrom is requested.

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CONCLUSION

The Appellants respectfully submit that claims 1-16 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: April 12, 2005

Respectfully submitted,
ANTHONY E. MARTINEZ, *et al.*

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